Applicants Provisionally Elect With Traverse

In response to the Office Action dated December 3, 1999 requiring restriction election, Applicants, as the requirement is best understood, provisionally elect with traverse Group I (claims 1-3 and 24-26). Applicants, as the requirement is best understood, also provisionally elect with traverse species I. Claims 1-44 are readable on species I. Claims 1, 24, 27, and 44 are generic.

Reconsideration and withdrawal of said requirements is respectfully requested.

The Definitions of the Groups Are Improper

Group II

The Action indicates Group II as drawn to "a rotary locking mechanism." However, all of the Group II claims are directly or indirectly dependent on claim 1. Claim 1 is drawn to a system for providing medical items, comprising a computer, user interface, refrigerator, and lock module. Therefore, the restriction requirement is based on an improper Group II definition. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Group III

The Action indicates Group III as drawn to "a system for attaching a locking mechanism to a refrigerator door." However, all of the Group III claims are directly or indirectly dependent on claim 1. Claim 1 is drawn to a system for providing medical items, comprising a computer, user interface, refrigerator, and lock module. Therefore, the restriction requirement is based on an improper Group III definition. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Group IV

The Action indicates Group IV as drawn to "a system for reading identification indicia into a computer." However, all of the Group IV claims are directly or indirectly dependent on claim 1. Claim 1 is drawn to a system for providing medical items comprising a computer, user

interface, refrigerator, and lock module. Therefore, the restriction requirement is based on an improper Group IV definition. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Group V

The Action indicates Group V as drawn to "a locking module with self return mechanism." However, all of the Group V claims are directly or indirectly dependent on claim 1. Claim 1 is drawn to a system for providing medical items comprising a computer, user interface, refrigerator, and lock module. Therefore, the restriction requirement is based on an improper Group V definition. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Group VII

The Action indicates Group VII as drawn to "a method for attaching an access controlled locking mechanism to the dispenser." However, all of the Group VII claims are directly or indirectly dependent on claim 27. Claim 27 is drawn to a method comprising the steps of attaching a lock module; placing a medical item; storing in a data store data; inputting through an input device an input; determining with a computer; generating a signal with the computer; and enabling access. Therefore, the restriction requirement is based on an improper Group VII definition. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Group VIII

The Action indicates Group VIII as drawn to "a method for locking a door." However, all of the Group VIII claims are directly or indirectly dependent on claim 27. Claim 27 is drawn to a method comprising the steps of attaching a lock module; placing a medical item; storing in a data store data; inputting through an input device an input; determining with a computer; generating a signal with the computer; and enabling access. Therefore, the restriction requirement is based on an improper Group VIII definition. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

The Alleged Groups Are Not Distinct

Groups I and VI/VIII Are Not Distinct

The apparatus (Group I) has not been shown to practice another and materially different process

The Action asserts that Groups I and VI/VIII are related as apparatus and process for its practice. The Action further indicates that the Groups I and VI/VIII are distinct because "the apparatus or I may be used to vend beverages."

Applicants respectfully disagree. Group I, as admitted in the Action, is directed to "an access controlled refrigerated medicine storage and dispensing device." Group VI (and Group VIII whose claims depend on Group VI), as admitted in the Action, is directed to "a method for controlling a refrigerated medicine storage and dispensing device." Therefore, as admitted in the Action, the apparatus of Group I is directed to the process of Groups VI/VIII. It is not proper for the Action to admit that the apparatus of Group I is directed to a "medicine storage and dispensing device", and then allege that this same apparatus (Group I) can "be used to vend beverages." Therefore, the Action has not shown that the apparatus of Group I "can be used to practice another and materially different process", as is required (MPEP 806.05(e)). On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Furthermore, the Group I claims are clearly directed to and have the structure for "providing medical items" (claim 1). The Group I claims further recite "item data representative of a plurality of medical items" (claim 1). Applicants request evidence of a process of "vending beverages" using all of the recited features in the apparatus of Group I. That is, Applicants ask for evidence showing a beverage vending machine using a computer in operative connection with a data store, wherein the data store includes user data representative of a plurality of authorized users, wherein responsive to a user inputting identification data through an input device of a user interface corresponding to data representative of an authorized user, the computer enables the user to input medical item indicia corresponding to a medical item, and wherein the computer is operative to output a signal changing the lock module to an unlocked condition. Beverage vending machines are designed to be available to the public. Beverage vending machines are not

limited to only authorized users, as is expressly recited in all the claims of Group I. Nor do they require the input of identification data corresponding to one of these authorized users for their use, in the manner recited in Group I.

Furthermore, the economics of beverage vending machines is to use low-cost machines because the products sold are low cost. A beverage vending machine would not be permitted to use such an elaborate (security) system as recited in Group I.

The burden is on the Patent Office to provide a reasonable example (MPEP 806.05(e)). The Action has not shown any reasonable example of how the apparatus "may be used to vend beverages." Because the Action does not apply the required reasoning for the alleged restriction between Groups I and VI/VIII, Applicants have been required to speculate as to possible rationales for the restriction.

Again, Applicants challenge the assertions in the Action and request that the Patent Office provide evidence showing a beverage vending machine having the features recited in Group I, including a computer in operative connection with a data store having data representative of authorized users, input of medical item indicia, and a lock module. If the Patent Office does not provide such evidence, then the restriction should be withdrawn because it is clearly not reasonable.

"If Applicant proves or provides convincing argument that there is no material difference or in the case of a process that cannot be preformed by hand (if examiner so argued), the burden is on the examiner to document another materially different process or apparatus or withdraw the requirement" (MPEP 806.05(e)). Applicants, in the reasons presented above, have shown that the apparatus as claimed cannot be used to practice the alleged process. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

The process (Group VI) has not been shown to be practiced by another materially different apparatus or by hand

The Action also states that "process VI may be used to recognize the presence of medical inventory within a storage location."

Applicants respectfully disagree. The Patent Office is required to show that the process of Group VI "can be practiced by another materially different apparatus or by hand." The Action has merely asserted that the process of Group VI can be used in another process, e.g., "to recognize the presence of medical inventory within a storage location." Hence, the Action has not met the basic requirements for a proper restriction between Group I and Group VI. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Furthermore, Group I is capable of recognizing "the presence of medical inventory within a storage location." Group I clearly recites that "a storage location for at least one medical item is stored in an interior area of the refrigerator" (e.g., claim 1). For a proper restriction requirement the Patent Office is required "to provide reasonable examples that recite material differences" (MPEP 806.05(e)).

Furthermore, what specific language in Group I prevents Group I from being "used to recognize the presence of medical inventory within a storage location?" There isn't any. Therefore, the Action has not shown that the process of Group VI "can be practiced by another materially different apparatus or by hand", as is required (MPEP 806.05(e)).

The process (Group VIII) has not been shown to be practiced by another materially different apparatus or by hand

The Action also states that "process VIII may be used to a lock to a house, office, or vault."

Applicants respectfully disagree. Group VIII consists of dependent claims 39-40, both of which directly or indirectly depend on independent claim 27, which belongs to Group VI. Therefore, the same arguments used against the restriction regarding Group I and Group VI are herein incorporated by reference.

Furthermore, the Patent Office is required to show that the process of Group VIII "can be practiced by another materially different apparatus or by hand." The Action has merely stated that the process of Group VIII can be used in another process, e.g., "may be used to a lock to a house, office, or vault." Hence, the Action has not met the basic requirements for a proper

restriction between Group I and Group VIII. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Furthermore, Group VIII is not capable of the alleged use. As previously stated, Group VIII consists of dependent claims 39-40, both of which directly or indirectly depend on independent claim 27, which belongs to Group VI. Group VI, as admitted in the Action, is directed to "a method for controlling a refrigerated medicine storage and dispensing device." Hence, Group VIII is also directed to that method. Therefore, Group VIII cannot be "used to a lock to a house, office, or vault." On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Furthermore, Group I, as admitted in the Action, is directed to "an access controlled refrigerated medicine storage and dispensing device." Therefore, the process of Group VIII is directed to the apparatus of Group I. Therefore, the Action has not shown that the process of Group VIII "can be practiced by another materially different apparatus or by hand", as is required (MPEP 806.05(e)). On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Groups I and II-V Are Not Distinct

The Action indicates that Group I and Groups II-V are related as combination (Group I) and subcombinations (Group II-V).

Applicants disagree. In order to establish that combination and subcombination inventions are distinct, two-way distinctness must be demonstrated (MPEP 806.05(c)). The Patent Office must show both (A) that the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (B) that the subcombination has utility by itself or in other combinations. The Action alleges that the subcombination has separate utility.

This allegation is without legal basis. It is not proper to allege an independent claim as a combination and claims which depend from said independent claim (i.e., dependent claims) as subcombinations.

Each of the claims in the alleged subcombinations (Groups II-V) is a dependent claim that is directly or indirectly dependent on independent claim 1 (Group I). Therefore, each of the

Groups II-V is dependent on and includes the subject matter of claim 1 (Group I). Claim 1 is drawn to a combination (Group I), as admitted in the Action. Therefore, each of the claims in the Groups II-V include the same combination of claim 1. Therefore, each of the Groups II-V include the same combination of Group I. Each of the alleged subcombinations include the alleged combination. As a result the Groups II-V automatically include the utility of Group I. Group I is actually broader than any of the Groups II-V. Therefore, Group I can match any utility that the Groups II-V may have. The allegation in the Action that the subcombinations (Groups II-V) have "separate utility" (apart from the claimed combination) is in clear error. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Also, the Action has not shown that each alleged subcombination has utility by itself or in other combinations, as is required (MPEP 806.05(c)). Since this has not been shown, the alleged inventions are not distinct (MPEP 806.05(c)). On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Groups I and VII Are Not Distinct

The Action states that "Inventions I and VII are related as process of making and product made" (MPEP 806.05(f)).

Applicants disagree. Group I, as admitted in the Action, is directed to "an access controlled refrigerated medicine storage and dispensing device." Hence, Group I is not directed to "a process of making." On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Group VII consists of dependent claims 28-30, which directly or indirectly depend on independent claim 27, which belongs to Group VI. Group VI, as admitted in the Action, is directed to "a method for controlling a refrigerated medicine storage and dispensing device." Hence, Group VII is also directed to said method. Group VII is not directed to a "product made." On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

The Action further states that the "process may be used to attach a lock to an office or house."

Applicants disagree. The Patent Office is required to show that the process of Group VII "can be practiced by another materially different apparatus or by hand." The Action has merely asserted that the process of Group VII can be used in another process, e.g., "used to attach a lock to an office or house." Hence, the Action has not met the basic requirements for a proper restriction between Group I and Group VII. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Furthermore, Group VII is not capable of the alleged use. Group VII, as admitted in the Action, is directed to "a method for attaching an access controlled locking mechanism to the dispenser." Therefore, Group VII cannot be "used to attach a lock to an office or house." On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Also, as previously stated, Group VII consists of dependent claims 28-30, which directly or indirectly depend on independent claim 27, which belongs to Group VI. Group VI, as admitted in the Action, is directed to "a method for controlling a refrigerated medicine storage and dispensing device." Hence, Group VII is also directed to such a method. Therefore, Group VIII cannot be "used to attach a lock to an office or house." On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Furthermore, Group I, as admitted in the Action, is directed to "an access controlled refrigerated medicine storage and dispensing device." Therefore, the process of Group VII is directed to the apparatus of Group I. The Patent Office has not shown that the process of Group VII "can be practiced by another materially different apparatus or by hand", as is required (MPEP 806.05(e)). On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Groups II, III, IV and V Are Not Distinct

The Action alleges separate utility among the Groups II, III, IV, and V.

Applicants disagree. "The Examiner must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination. Care must be taken to determine if the subcombinations are generically claimed." (MPEP 806.05 (d)).

As previously argued, each of the claims in the alleged subcombinations (Groups II-V) is a dependent claim that is directly or indirectly dependent on independent claim 1 (Group I). Therefore, each of the Groups II-V is dependent on and includes the common subject matter of claim 1 (Group I). Therefore, each of the Groups II-V includes the same utility as Group I. None of the subcombinations has utility other than in the disclosed combination. Group I, as admitted in the Action, is directed to "an access controlled refrigerated medicine storage and dispensing device." Therefore, the allegation in the Action that the subcombinations (Groups II-V) have "separate utility" is in clear error. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

"If Applicant proves or provides an argument, supported by facts, that the other use, suggested by the examiner, cannot be accomplished or is not reasonable, the burden is on the examiner to document a viable alternative use or withdraw the requirement." (MPEP 806.05 (d)). Applicants, in the reasons presented above, have shown that the alleged "separate utility" cannot be accomplished and is not reasonable. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Groups VI and VIII Are Not Distinct

The Action alleges that Groups VI and VIII are related as combination and subcombination. The Action states that the combination (VI) does not require the particulars of the subcombination because "the dispensing of medicine and monitoring of inventory do not require a locking mechanism." The Action also states that the subcombination (VIII) has "separate utility such as locking the door of a safe."

Applicants disagree. In order to establish that combination and subcombination inventions are distinct, two-way distinctness must be demonstrated (MPEP 806.05(c)). The Patent Office must show both (A) that the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (B) that the subcombination has utility by itself or in other combinations.

The allegation in the Action is without legal basis. It is not proper to allege an independent claim as a combination and claims which depend from that same independent claim (i.e., dependent claims) as a subcombination.

Each of the claims in the alleged subcombination (Group VIII) is a dependent claim that is directly or indirectly dependent on independent claim 27 (Group VI). Therefore, Group VIII is dependent on and includes the subject matter of claim 27 (Group VI). Claim 27 is drawn to a combination (Group VI), as admitted in the Action. Therefore, each of the claims in Group VIII includes the same combination as recited in claim 27. Therefore, Group III includes the same combination of Group I. The alleged subcombination includes the alleged combination. Therefore, Group VIII automatically includes the utility of Group VI. Group VI is actually broader than Group VIII. Therefore, Group VI can match any utility that Group VIII may have. The allegation in the Action that the subcombination (Group VIII) has "separate utility" (apart from the claimed combination) is in clear error. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Furthermore, Group VIII is not capable of the alleged use. Group VI, as admitted in the Action, is directed to "a method for controlling a refrigerated medicine storage and dispensing device." Group VIII, by being dependent on Group VI, is also directed to said method. Therefore, Group III cannot be used as "a method for locking a door." On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Groups VII and Viii Are Not Distinct

The Action alleges that Groups VII and VIII are related as subcombinations.

Applicants disagree. "The examiner must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination. Care must be taken to determine if the subcombinations are generically claimed." (MPEP 806.05 (d)).

The Action provides no showing or example. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Furthermore, each of the claims in the alleged subcombinations (Groups VII and VIII) is a dependent claim that is directly or indirectly dependent on independent claim 27 (Group VI).

Each of the Groups VII and VIII is dependent on and includes the common subject matter of claim 27 (Group VI). Therefore, each of the Groups VII and VIII includes the same utility as Group VI. None of the subcombinations has utility other than in the disclosed combination. Group VI, as admitted in the Action, is directed to "a method for controlling a refrigerated medicine storage and dispensing device." Therefore, the allegation in the Action that the subcombinations (Groups VII and VIII) have "separate utility" is in clear error. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

"If Applicant proves or provides an argument, supported by facts, that the other use, suggested by the examiner, cannot be accomplished or is not reasonable, the burden is on the examiner to document a viable alternative use or withdraw the requirement." (MPEP 806.05 (d)). Applicants, in the reasons presented above, have shown that the alleged "separate utility" cannot be accomplished and is not reasonable. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Groups VI and VII Are Not Distinct

The Action alleges that Groups VI and VII are related as subcombinations.

Applicants disagree. "The examiner must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination. Care must be taken to determine if the subcombinations are generically claimed." (MPEP 806.05 (d)).

This allegation is without legal basis. It is not proper to allege an independent claim as a subcombination and claims which depend from said independent claim (i.e., dependent claims) also as a subcombination.

Each of the claims in the alleged Group VII subcombination is a dependent claim that is directly or indirectly is dependent on and includes the common subject matter of claim 27 (Group VI). Therefore, Group VII includes the same utility as Group VI. Therefore, the Group VII subcombination does not have separate utility from the Group VI subcombination. Nor does the Group VI subcombination have separate utility from the Group VII subcombination. Group VI, as admitted in the Action, is directed to "a method for controlling a refrigerated medicine storage and dispensing device." Therefore, the allegation that Group VI and Group VII are

subcombinations having "separate utility" is in clear error. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

The Action also states that "invention VI has separate utility such as a dispenser of medicine."

Applicants disagree. As previously discussed, Group VII (which is dependent on Group VI) would also have "utility such as a dispenser of medicine."

The Action also states that "invention VII has separate utility such as the mechanical attachment of subsystems to each other."

Applicants disagree. As previously discussed, Group VI (from which Group VII depends) would also be capable of such utility.

The Action also states that "the product may be dispensed without utilizing a processor or terminal or without comparing id codes."

Applicants disagree. The Action has not stated which Group is directed to the alleged "product." Nevertheless, as previously discussed, since Group VII is dependent on Group VI, they would have the same utility.

"If Applicant proves or provides an argument, supported by facts, that the other use, suggested by the examiner, cannot be accomplished or is not reasonable, the burden is on the examiner to document a viable alternative use or withdraw the requirement." (MPEP 806.05 (d)). Applicants, in the reasons presented above, have shown that the alleged "separate utility" cannot be accomplished and is not reasonable. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Groups I and III Are Not Distinct

The Action alleges that Groups I and III are related as combination and subcombination.

Applicants disagree. In order to establish that combination and subcombination inventions are distinct, two-way distinctness must be demonstrated (MPEP 806.05(c)). The Patent Office must show both (A) that the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (B) that the subcombination has utility by itself or in other combinations.

Each of the claims in the alleged subcombination (Group III) is a dependent claim that is directly or indirectly dependent on independent claim 1 (Group I). Therefore, Group III is dependent on and includes the subject matter of claim 1 (Group I). Claim 1 is drawn to a combination (Group I), as admitted in the Action. Therefore, each of the claims in Group III include the same combination of claim 1. Group III includes the same combination of Group I. Therefore, the alleged subcombination includes the alleged combination. Therefore, Group III automatically includes the utility of Group I. Group I is actually broader than Group III. Therefore, Group I can match any utility that Group III may have. The allegation in the Action that the subcombination (Group III) has "separate utility" (apart from the claimed combination) is in clear error. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

The Action has not shown that alleged subcombination has utility by itself or in other combinations, as is required (MPEP 806.05(c)). Since this has not been shown, the alleged inventions are not distinct (MPEP 806.05(c)). On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Furthermore, Group III is not capable of the alleged use. Group III, as admitted in the Action, is directed to "a system for attaching a locking mechanism to a refrigerator door." Therefore, Group III cannot be used as "a transaction logger and a characteristic profiler for recipients of the sample." On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Groups II and IV Are Not Distinct

The Action alleges that the Groups II and IV are related as combination and subcombination.

Applicants disagree. In order to establish that combination and subcombination inventions are distinct, two-way distinctness must be demonstrated (MPEP 806.05(c)). The Action must show both (A) that the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (B) that the subcombination has utility by itself or in other combinations.

Each of the claims in the alleged combination (Group II) and subcombination (Group IV) is a dependent claim that is directly or indirectly dependent on independent claim 1 (Group I). Therefore, both Group II and Group IV each are dependent on and include the subject matter of claim 1 (Group I). To state that Group II is a combination, and Group IV is a subcombination is improper.

Furthermore, Group II can match any utility that Group IV may have. Therefore, the allegation that the subcombination (Group IV) has "separate utility" is in clear error. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

What specific language in Group II prevents Group II from being used as "a transaction logger and a characteristic profiler for recipients of the sample?" There isn't any. Therefore, the Action has not shown that the alleged subcombination of Group IV has "separate utility", as is required (MPEP 806.05(c)). On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Furthermore, Group IV is not capable of the alleged use. Group IV, as admitted in the Action, is directed to "a system for reading identification indicia into a computer." Therefore, Group IV cannot be used as "a transaction logger and a characteristic profiler for recipients of the sample." On this basis it is respectfully submitted that the restriction requirement should be withdrawn. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Groups III and IV Are Not Distinct

The Action alleges that the Groups III and IV are related as process and apparatus for its practice (MPEP 806.05(e)).

Applicants disagree. Group III, as admitted in the Action, is directed to a system for attaching a locking mechanism to a refrigerator door." Group IV, as admitted in the Action, is directed to "a system for reading identification indicia into a computer." Therefore, neither Group III nor Group IV is directed to a "process", as alleged in the Action. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

The Action Lacks Examples Of Distinctness Between All Alleged Groups

It is noted that the Action does not show, by way of example, distinctness between all of the alleged Groups. Distinctness has not been shown between Group II and each of the Groups VI; VII; and VIII. Nor has distinctness been shown between Group III and each of the Groups VI; VII; and VIII. Nor has distinctness been shown between Group IV and each of the Groups VI; VII; and VIII. Nor has distinctness been shown between Group V and each of the Groups VI; VII; and VIII. Nor has distinctness been shown between Group VII and Group VIII.

Therefore, restriction of said alleged Groups is improper. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

The Species Requirement

It is respectfully submitted that the Action is vague and indefinite, and does not properly describe which species are being alleged. Nor has the Action stated how the alleged species are directed to different embodiments. The Action has not stated the generic or common characteristic linking the alleged species. The Patent Office is specifically requested to answer (1) where the alleged species occur in the claims, and (2) what is the common characteristic linking the alleged species? The Action leaves Applicants the burden of properly responding to a confusing, contradicting, and improper requirement. On this basis it is respectfully submitted that the requirement should be withdrawn.

MPEP 806.04(e) states that "Species are always the specifically different embodiments."

MPEP 806.04(f) states:

> Claims to be restricted to different species must be mutually exclusive. The general test as to when claims are restricted, respectively, to different species is the fact that one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first. This is frequently expressed by saying that claims to be restricted to different species must recite the mutually exclusive characteristics of such species.

It appears that Applicants' claims do not recite the alleged species relating to "a data terminal input device." Furthermore, the term "terminal" does not appear in any claim. On this basis it is respectfully submitted that the requirement should be withdrawn.

Additionally, the Action has not indicated which "claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first" as is required in order to meet the "general test" stated in MPEP 806.04(f). On this basis it is respectfully submitted that the requirement should be withdrawn.

Applicants' Specification at page 8, lines 12-13, states that the invention includes "a data terminal which includes a user interface and which terminal is connected to the processing system and the counters." Furthermore, Applicants' Specification at page 10, lines 16-18, states that "The data terminal preferably includes a reader for reading the coded object and for receiving the user's PIN number which has a predetermined relationship to the data on the encoded object."

The Action alleges that the species are directed to a "data terminal input device" and a "reading identification indicia input device." However, the Specification, as shown above, recites that the data terminal **includes** the user interface and that the data terminal **includes** the reader. That is, it would appear that the data terminal (alleged species I) encompasses the reader (alleged species II). Therefore, it is unclear how the Action can allege two mutually exclusive species when the Specification clearly indicates otherwise. On this basis it is respectfully submitted that the requirement should be withdrawn.

Applicants, as the requirement is best understood, provisionally elect with traverse species I. Claims 1-44 are readable on species I. Hence, at least the independent claims 1, 24, 27, and 44 are generic.

The Action Is Unclear

The restriction requirement does not provide Applicants with clear examples distinguishing the Groups as independent and distinct from each other. Nor does the species requirement properly describe which species are being alleged. The Action leaves Applicants the

burden of properly responding to confusing, contradicting, and improper requirements. On this basis it is respectfully submitted that the requirements should be withdrawn.

Furthermore, the Action does not present a straightforward and clear restriction and species requirements based on the laws, regulations, and Patent Office procedures. The Action appears to be a failed attempt to puzzle together non fitting restriction and species pieces. The Action has also obfuscated the issue, because there is no proper restriction or species requirement to be made. On this basis it is respectfully submitted that the requirements should be withdrawn.

The Restriction Requirement Is Without Legal Basis

Applicants additionally respectfully wish to point out that the Action fails to state a legally proper test for imposing a restriction requirement. The Action indicates that the restriction requirement is solely based on a showing of the alleged inventions being "distinct." The statutory authority for the Patent Office to impose a restriction requirement is found in 35 U.S.C. § 121. The statute expressly states that before the Patent Office may require restriction, the inventions must be both "independent" and "distinct." The regulations that have been promulgated pursuant to this statute, 37 C.F.R. § 1.141 and 37 C.F.R. § 1.142, both expressly state that before a restriction requirement may be imposed the inventions claimed must be both independent and distinct.

In the Action, there are only unsupported assertions that the sets of claims are "distinct." There are no assertions that the sets of claims are "independent", as is required. This standard does not comply with the statutory requirements. Therefore the reasons asserted in the Action for seeking to impose the restriction requirements are legally insufficient due to noncompliance with the clear wording of both the statute and the regulations promulgated thereunder.

Furthermore, the Patent Office has acknowledged that before claimed inventions can be considered to be "independent" the inventions must be unconnected in design, operation, or effect. MPEP § 802.01. All the claims directed to Applicants' invention are related in design, operation, and effect. Thus, the statutory requirements are not met and no restriction requirement may be imposed.

Conclusion

The restriction requirement is respectfully traversed. None of the alleged Groups are distinct from any of the other alleged Groups. Nor is the species requirement proper. Therefore, it is respectfully requested that the restriction and species requirements be withdrawn.

The undersigned will be happy to discuss any aspect of the Application by telephone at the Examiner's convenience.

Respectfully submitted,

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